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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/502,664      | 02/11/2000  | Ronald D. Vale       | REGEN1500-1         | 5502             |

7590 09/15/2003

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EXAMINER

ROBINSON, HOPE A

ART UNIT PAPER NUMBER

1653

DATE MAILED: 09/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                        |                                      |                                    |  |
|------------------------|--------------------------------------|------------------------------------|--|
| <b>Advisory Action</b> | <b>Application No.</b><br>09/502,664 | <b>Applicant(s)</b><br>VALE ET AL. |  |
|                        | <b>Examiner</b><br>Hope A. Robinson  | <b>Art Unit</b><br>1653            |  |

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 29 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 3, 8, 104-111.

Claim(s) rejected: 1, 4-7, 9-12.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's response to the Final Office Action mailed April 22, 2003 on July 29, 2003 is acknowledged.
2. Applicant's arguments filed July 29, 2003 have been fully considered but are not persuasive.

The rejections under 35 U.S.C. 102 have been maintained.

### ***Claim Disposition***

3. Claims 2 and 13-103 have been canceled. Claims 1, 3, 8-10, 106 and 107 have been amended. Claims 1, 3-12 and 104-111 are pending and under examination.

### ***Claim Objections***

4. Claims 8 and 107 are objected to for the recitation of "polacryloylmorpholide" which is misspelled and should be "polyacryloylmorpholide".

Claims 3, 8 and 104-111 are objected to as depending from rejected based claims.

5. Claims 1, 4-7 and 9-12 remain rejected under 35 U.S.C. 102(b) as being anticipated by Griffin et al. (Science, vol. 281, pages 269-272, July 10, 1998). For the reasons set forth in the office action mailed April 22, 2003.
6. Claims 1, 4-7 and 9-12 remain rejected under 35 U.S.C. 102(a) as being anticipated by Tsien et al. (U.S. Patent No. 6,008,378, December 28, 1999). For the reasons set forth in the office action mailed April 22, 2003.

7. The amendment filed July 29, 2003 has been fully considered. Applicant state that the invention is directed to a FlAsH compound which has been modified by acylation with an amino acid, not acylation with an anhydride, tautomer or salt (see pages 6-10 of the response). However, this argument is not persuasive because the plain language of the claim is "a) contacting a modified Fluorescein arsenical helix binder (FlAsH) compound, which has been modified by acylation with an amino acid, or a tautomer, anhydride or salt...". As the claim is written in the alternative, the meaning of that plain language is that FlAsH is acylated via an amino acid, or a tautomer, anhydride or salt. It is suggested that applicant amend the claim to achieve the intended meaning such as deleting the other terms "tautomer, anhydride or salt" or modifying the present claim language. Therefore, the rejections of record remains.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hope Robinson whose telephone number is (703) 308-6231. The examiner can normally be reached on Monday-Friday from 9.00 am to 6.30 pm (EST).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S.F. Low, Ph.D., can be reached at (703) 308-2923.

Any inquiries of a general nature relating to this application should be directed to the Group Receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted by facsimile transmission. The official fax phone number for Technology Center 1600 is (703) 308-4242. Please affix the examiner's name on a cover sheet attached to your communication should you choose to fax your response. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

Application/Control Number: 09/502,664  
Art Unit: 1653

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Hope Robinson, MS 

Patent Examiner

  
CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
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